

**Remarks:**

Claims 9-16, and 24-30 are pending.

Claims 9 and 24 have been amended.

Claims 1-8, 17-23, and 31-34 have been withdrawn from consideration.

**Elections/Restrictions:**

To affirm the election made in the telephone call to Applicants' representative on June 16, 2004, Applicants elect claims 9-16 and 24-30 without traverse.

**Claim Rejections:**

The Examiner rejected claims 9-12, 15-16, and 24-28 under 35 USC §102(e) as being anticipated by Dutta et al. (United States Patent Publication Number 2002/0138471). To the extent the rejection applies to the amended claims, Applicants respectfully traverse the rejection.

In general, Applicants respectfully submit that Dutta teaches a closed, private, paid service and system that enhances the search experience of individual users. Dutta teaches users installing special software and signing up for the service. Dutta's system teaches outputting some statistics about file usage of its users, and maintaining a list of other computers of its users that have responded affirmatively to a list of keyword searches of its users. Dutta does not teach or suggest the desirability of gathering lists of files in libraries from a general peer-to-peer universe or network. Dutta does not teach or suggest the desirability of passively acquiring shared file library information from users of a general peer-to-peer universe or network without requiring the users' action.

More specifically, Applicants respectfully submit that Dutta teaches a device for copying search requests or queries, "[0059] When a search has been completed, a peer node has compiled a list of query hits from other peer nodes that have reported the hits for the peer node's search query. In a preferred embodiment, search result post-

processor 322 obtains a copy of the search query and the compiled list of query hits. Keywords from completed search queries 326 are then indexed into the client rating database. [0060] As the user of the peer node retrieves and uses those files, search result post-processor 322 monitors the usage of the search result files and rates each file based on the usage of those files. Using functionality within the operating system of the peer node, the search result post-processor can perform a variety of actions to determine how and when the retrieved files are used. Depending on the type of file, various rating criteria can be established for each type of file. For example, if a user retrieves a digital video file, then the search result post-processor can monitor the number of times that the file is viewed. Other types of active content files can be monitored for the number of times that a file is played.” (Dutta, paragraphs 59-60).

Applicants respectfully submit that Dutta teaches copying a list of peer nodes that contain a file that meets the criteria of the search query. Dutta does not teach or suggest the desirability of requesting a library of shared files from each of a plurality of computers.

In the Office Action, regarding claim 9, the Examiner stated that Dutta teaches, “a query device adapted to request a library of shared files from a plurality of computers connected to the network.” Applicants respectfully traverse. As stated above, Dutta teaches only copying search queries, and does not teach or suggest the desirability of requesting a library of shared files from each of a plurality of computers.

In the Office Action, regarding claim 10, the Examiner stated that Dutta teaches “an inventory preparation server coupled to the database at paragraph 71 (client ratings database).” Applicants respectfully traverse. Claim 10 adds the additional element of an inventory preparation server to the existing elements of claim 9. Regarding claim 9, the Examiner stated that the client rating database of Dutta anticipates “a database coupled to the computer.” The Examiner has not shown how the client ratings database of Dutta anticipates both “a database coupled to the computer” and “an inventory preparation server coupled to the database.”

In the Office Action, regarding claim 11, the Examiner stated that Dutta teaches “an archiving system coupled to the database ... at paragraph 71 (client ratings

database).” Applicants respectfully traverse. Claim 11 adds the additional element of an archiving system to the existing elements of claim 9. Regarding claim 9, the Examiner stated that the client rating database of Dutta anticipates “a database coupled to the computer.” The Examiner has not shown how the client ratings database of Dutta anticipates both “a database coupled to the computer” and “an archiving system couple to the database.”

In the Office Action, regarding claim 12, the Examiner stated that Dutta teaches “an inventory processing server coupled to the database at paragraph 71.” Applicants respectfully traverse. Claim 12 adds the additional element of an inventory processing server to the existing elements of claim 9. Regarding claim 9, the Examiner stated that the client rating database of Dutta anticipates “a database coupled to the computer.” The Examiner has not shown how the client ratings database of Dutta anticipates both “a database coupled to the computer” and “an inventory processing server coupled to the database.”

In the Office Action, regarding claim 24, the Examiner stated that Dutta teaches, “requesting a listing of a library of shared files from each of said plurality of computers connected to the network.” Applicants respectfully traverse. As stated above, Dutta teaches only copying search queries, and does not teach or suggest the desirability of requesting a library of shared files from each of a plurality of computers.

Applicants respectfully request that the Examiner withdraw the rejection to amended independent claims 9 and 24, and allowable dependent claims 10–12, 15-16, and 25-28 for at least the reasons set forth above.

The Examiner rejected claims 13-14, and 29-30 under 35 USC §103(a) as being unpatentable over Dutta et al., in view of O’Kane, United States Publication Number 2003/0105831. To the extent the rejection applies to the amended claims, Applicants respectfully traverse the rejection.

Applicants respectfully submit that the Examiner has failed to set forth a prima facie case of obviousness. As set forth in the MPEP at section 2142, a prima facie case of obviousness has three requirements:

“First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.” (MPEP, Section 2142).

Applicants respectfully submit that O’Kane does not remedy the defects of Dutta discussed above. In addition, Applicants respectfully submit that there is no suggestion or motivation to combine the references.

For at least the reasons set forth above, applicants respectfully request that the Examiner withdraw the rejection to claims 13-14 and 29-30.


**Conclusion:**

Unless otherwise specifically noted, none of the amendments to the claims are for a reason related to patentability.

In view of the foregoing, Applicant respectfully submits that all pending claims are allowable, and respectfully requests a notice of allowance for claims 9-16, and 24-30. If the Examiner believes an interview would be helpful in moving the application forward to allowance, or has any questions, the Examiner is invited to call the undersigned at the telephone number listed below.

Date: 10/4/04  
Hickman Patent Law Offices  
4640 Cedar Street  
Bellaire, Texas 77401  
Telephone: 281-222-3497  
Docket No. 09401.P001

Respectfully submitted,

  
William E. Hickman  
Registration No. 46,771

CERTIFICATE OF MAILING	
DATE OF DEPOSIT:	<u>10/4/04</u>
I hereby certify that this paper and fee are being deposited with the United States Postal Service to Addressee on the date indicated above and is addressed to the Commissioner of Patents and Trademarks, P.O. Box 1450, Alexandria, VA 22313-1450.	
TYPE OR PRINT NAME	<u>William Hickman</u>
SIGNATURE	